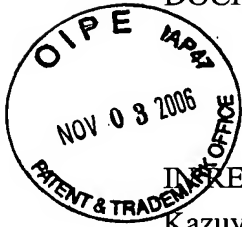


DOCKET NO.: 254578US0X PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



IN RE APPLICATION OF:

Kazuya TANAKA, et al.

SERIAL NO: 10/500,892

GROUP: 1762

FILED: July 7, 2004

EXAMINER: E. C. CAMERON

FOR: AQUEOUS AGENT FOR TREATING SUBSTRATE, METHOD FOR
TREATING SUBSTRATE AND TREATED SUBSTRATE

LETTER

Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is a Chinese Office Action with English Translation for the
Examiner's consideration.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
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The Patent Office of the People's Republic of China

Address: No. 6 XITUCHENG ROAD, JIMEN BRIDGE, HAIDIAN DISTRICT, BEIJING

Post code: 100088

Applicant: NIHON PARKERIZING CO., LTD.	ISSUING DATE: September 8, 2006
Agent: Renlin ZHAO; Pingyuan ZHANG	
Application No.: 038021676	
Title: AQUEOUS AGENT TREATING SUBSTRATE, METHOD FOR TREATING SUBSTRATE, AND TREATED SUBSTRATE	

THE FIRST OFFICE ACTION

(PCT Application Entering the Chinese National Phase)

1. ☒ According to Article 35 Paragraph 1 of the Patent Law, the examiner conducted a substantive examination to the above-mentioned patent application upon the applicant's request.
☐ According to Article 35 paragraph 2 of the Patent Law, Chinese Patent Office decided on its own initiative to conduct a substantive examination to the above-mentioned patent application.
2. ☒ The applicant requested to take
 January 11, 2002 on which an application is filed with the JP patent office as the priority date.
 _____ on which an application is filed with the _____ patent office as the priority date.
 _____ on which an application is filed with the _____ patent office as the priority date.
3. ☐ The amendment(s) below is/are not in conformity with Article 33 of the Patent Law:
 ☐ The Chinese translations of the annexes of International Preliminary Examination Report.
 ☐ The Chinese translations of the amendments made under Article 19 of the PCT.
 ☐ The amendments made under Articles 28 or 41 of the PCT.
 ☐ The amendments made under Rule 51 of the Implementing Regulations.
4. ☒ The examination has been conducted based on the Chinese translation of the international application text as originally filed.
 ☐ The examination has been conducted based on the following text(s):
 The description page(s)____, based on the Chinese translation of the international application text as originally filed.
 page(s)____, based on the Chinese translations of the annexes of International Preliminary Examination Report
 page(s)____, based on the Chinese translation of the amendments made under Articles 28 or 41 of the PCT.
 page(s)____, based on the amendments made under Rule 51 of the Implementing Regulations.
 The claims Claim(s)____, based on the Chinese translation of the international application text as originally filed.
 Claim(s)____, based on the Chinese translations of the amendments made under Article 19 of the PCT.
 Claim(s)____, based on the Chinese translations of the annexes of International Preliminary Examination Report.
 Claim(s)____, based on the Chinese translation of the amendments made under Articles 28 or 41 of the PCT.
 Claim(s)____, based on the amendments made under Rule 51 of the Implementing Regulations.
 The drawings page(s)____, based on the Chinese translation of the international application text as originally filed.
 page(s)____, based on the Chinese translations of the annexes of International Preliminary Examination Report.
 page(s)____, based on the Chinese translation of the amendments made under Articles 28 or 41 of the PCT.
 page(s)____, based on the amendments made under Rule 51 of the Implementing Regulations.

5. ☐ The following reference document(s) is/are cited (the reference numeral(s) thereof will be used in the examination procedure thereafter)

No.	Reference No. or Title	Publishing Date
1		
2		
3		

6. Concluding comments

- ☐ on the specification:

- ☐ The inventions belong to unpatentable subject matter as prescribed by Article 5 of the Patent Law.
☐ The specification is not in conformity with the provision of Article 26, paragraph 3 of the Patent Law.
☐ The writing of the specification is not in conformity with the provision of Rule 18 of the Implementing Regulations.
☐

- ☒ on the claims:

- ☐ Claim(s)_____do(es) not possess novelty as requested by Article 22 paragraph 2 of the Patent Law.
☐ Claim(s)_____do(es) not possess inventiveness as requested by Article 22 paragraph 3 of the Patent Law.
☐ Claim(s)_____belong(s) to non-patentable subject matter as prescribed by Article 25 of the Patent Law.
☒ Claim(s) 1,5 do(es) not comply with the provision of Article 26 paragraph 4 of the Patent Law.
☐ Claim(s)_____do(es) not comply with the provision of Article 31 paragraph 1 of the Patent Law.
☐ Claim(s)_____do(es) not comply with the provision of Article 9 of the Patent Law.
☒ Claim(s) 1,3,8 do(es) not comply with the provision of Rule 20 of the Implementing Regulations.
☒ Claim(s) 1 do(es) not comply with the provision of Rule 21 of the Implementing Regulations.
☐ Claim(s)_____do(es) not comply with the provision of Rule 22 of the Implementing Regulations.
☐ Claim(s)_____do(es) not comply with the provision of Rule 23 of the Implementing Regulations.

The detailed analysis for the above concluding comments is presented on the text of this Office Action.

7. Based on the above concluding comments, the examiner is of the opinion that

- ☒ The applicant should amend the application document(s) in accordance with the requirement as specified in the Office Action.
☐ The applicant should, in his observation, expound the patentability of the application, and amend the defects pointed out in the Office Action; or the application can hardly be approved.
☐ The examiner deems that the application lacks substantive features to make it patentable. Therefore, the application will be rejected if no convincing reasons are provided to prove its patentability.
☐

8. The applicant should pay attention to the following matters:

- (1) According to Article 37 of the Patent Law, the applicant is required to submit his observations within 4 months upon receipt of this Office Action. If the time limit for making response is not met without any justified reason, the application will be deemed to have been withdrawn.
- (2) The amendment(s) made by the applicant must meet the requirements of Article 33 of the Patent Law. The amended text should be in duplicate, its format should conform to the related confinement in the Guidelines for Patent Examination.
- (3) The observation and/of the amended document(s) must be mailed or delivered to the Receiving Section of the Chinese Patent Office. No legal effect shall apply for any document(s) that are not mailed to or reached the Receiving Section.
- (4) The applicant and/or the agent should not go to the Chinese Patent Office to interview the examiner without being invited.

9. The text of this Office Action contains 2 page(s), and has the following attachment(s):

- ☐ _____copy of the cited references, all together _____pages.

COMMENTS OF THE EXAMINER

The present application relates to water-based substrate treatment composition, method for treating substrate with said composition and the metal material treated with said method. After examination, the comments are provided as follows:

1. Claims 1 and 3 are unclear, which do not comply with the provision of Rule 20, paragraph 1 of the Implementing Regulations of the Patent Law. Claim 1 mentions “(A) at least one chitosan selected from chitosan and a chitosan derivative”. The former “chitosan” and the latter “chitosan” have the same names “chitosan”, but they actually refer to different substances. This renders Claim 1 unclear. The feature in Claim 3 that “said chitosan derivative is chitosan” is unclear in logic.
2. Claims 1 and 5 are not supported by the description, which do not comply with the provision of Article 26, paragraph 4 of the Patent Law. The term “chitosan derivative” in Claim 1 covers broad scope. According to the illustration in the description, when synthesizing said “chitosan derivative”, i.e., introducing the substituent groups onto the chitosan, the degree of introduction of substituent groups may be in a range of 6.0 at the maximum based on the monomer unit in chitosan, and the degree of introduction over 6.0 will lead to the deteriorated waterproofness. Thus, not all the “chitosan derivatives” achieve the same technical effects. Said summarization is not supported by the description. “M” in the Claim 5 of the Chinese version is not presented in the description, which renders Claim 5 not supported by the description.
3. Claim 1 lacks essential technical feature, which does not comply with the provision of Rule 21, paragraph 2 of the Implementing Regulations of the Patent Law. Claim 1 relates to a water-based substrate treatment composition. According to the illustration in the description, the technical problem the present invention aims to solve is that the resin coating layers of the metal materials obtained from the treatment composition in the prior art are insufficient in all of durable adhesive properties, solvent resistance and the corrosion resistance of the metal material. The technical solution for solving the aforesaid problem is to treat the substrate with the water-based substrate treatment composition having certain concentration and ratio of chitosan and specific metal compound. However, Claim 1 lacks the concentration of them and the ratio of the chitosan (A) to the metal compound. As to the composition, the concentration and ratio of each component are indispensable, as the composition of different concentrations and ratios have significantly different effects. Therefore, the applicant should incorporate the technical features relating to

the concentration and the ratio of each component which are indispensable to the solution of the technical problem.

4. Claim 8 is unclear, which does not comply with the provision of Rule 20, paragraph 1 of the Implementing Regulations of the Patent Law. The wording “such as” defines different protection scope within one claim, which renders the protection scope of the claim unclear.

For the above-mentioned reasons, the application cannot yet be allowed based on the current text. If the applicant submits the amended documents to overcome the defects pointed out in the Action within the time limit specified, the present application is likely to be granted a patent right. Otherwise, this application will be finally rejected. Please note that any amendment shall conform to the provisions of Article 33 of the Chinese Patent Law and shall not go beyond the scope of the disclosure contained in the initial description and claims.


The applicant should submit his response with the documents as follows: (1) a copy of the original document where the amendments are made. He should highlight the points where he adds, deletes and replaces the document in red pen or ball pen; (2) re-typed substitute pages. The applicant is kindly reminded to keep the consistency of the above mentioned documents.

HEB



中华人民共和国国家知识产权局

PLH107196A

邮政编码: 100101 北京市朝阳区北辰东路8号汇宾大厦 A0601 北京市柳沈律师事务所 贾静环, 宋莉	发文日期
申请号: 038021676	
申请人: 日本帕卡澳精株式会社, 大日精化工业株式会社	
发明创造名称: 处理基材的含水试剂、基材处理方法才已处理的基材	

第一次审查意见通知书

(进入国家阶段的 PCT 申请)

- ☒ 应申请人提出的实审请求, 根据专利法第 35 条第 1 款的规定, 国家知识产权局对上述发明专利申请进行实质审查。
☐ 根据专利法第 35 条第 2 款的规定, 国家知识产权局专利局决定自行对上述发明专利申请进行审查。
- ☒ 申请人要求以其在:
JP 专利局的申请日 2002 年 01 月 11 日为优先权日,
专利局的申请日 年 月 日为优先权日,
专利局的申请日 年 月 日为优先权日。
- ☐ 申请人于 年 月 日提交的修改文件, 不符合专利法实施细则第 51 条的规定。
☐ 申请人提交的下列修改文件不符合专利法第 33 条的规定。
☐ 国际初步审查报告附件的中文译文。
☐ 依据专利合作条约第 19 条规定所提交的修改文件的中文译文。
☐ 依据专利合作条约第 28 条或 41 条规定所提交的修改文件。
☐
- ☒ 审查是针对原始提交的国际申请的中文译文进行的。
☐ 审查是针对下述申请文件进行的:
☐ 说明书 第 页, 按照原始提交的国际申请文件的中文译文;
第 页, 按照国际初步审查报告附件的中文译文;
第 页, 按照依据专利合作条约第 28 条或 41 条规定所提交的修改文件;
第 页, 按照依据专利法实施细则第 51 条规定所提交的修改文件。
☐
☐ 权利要求 第 项, 按照原始提交的国际申请文件的中文译文;
第 项, 按照依据专利合作条约第 19 条规定所提交的修改文件的中文译文;
第 项, 按照国际初步审查报告附件的中文译文;
第 项, 按照依据专利合作条约第 28 条或 41 条所提交的修改文件;
第 项, 按照依据专利法实施细则第 51 条规定所提交的修改文件。
☐
☐ 附图 第 页, 按照原始提交的国际申请文件的中文译文;
第 页, 按照国际初步审查报告附件的中文译文;
第 页, 按照依据专利合作条约第 28 条或 41 条所提交的修改文件;
第 页, 按照依据专利法实施细则第 51 条规定所提交的修改文件。



☐

☐本通知书引用下述对比文献(其编号在今后的审查过程中继续沿用):

编号

文件号或名称

公开日期(或抵触申请的申请日)

5. 审查的结论性意见:

☐关于说明书:

- ☐申请的内容属于专利法第 5 条规定的不授予专利权的范围。
- ☐说明书不符合专利法第 26 条第 3 款的规定。
- ☐说明书不符合专利法第 33 条的规定。
- ☐说明书的撰写不符合专利法实施细则第 18 条的规定。

☒关于权利要求书:

- ☐权利要求 不具备专利法第 22 条第 2 款规定的新颖性。
- ☐权利要求 不具备专利法第 22 条第 3 款规定的创造性。
- ☐权利要求 不具备专利法第 22 条第 4 款规定的实用性。
- ☐权利要求 属于专利法第 25 条规定的不授予专利权的范围。
- ☒权利要求 1, 5 不符合专利法第 26 条第 4 款的规定。
- ☐权利要求 不符合专利法第 31 条第 1 款的规定。
- ☐权利要求 不符合专利法第 33 条的规定。
- ☐权利要求 不符合专利法实施细则第 13 条第 1 款的规定。
- ☐权利要求 不符合专利法实施细则第 2 条第 1 款关于发明的定义。
- ☒权利要求 1, 3, 8 不符合专利法实施细则第 20 条的规定。
- ☒权利要求 1 不符合专利法实施细则第 21 条的规定。
- ☐权利要求 不符合专利法实施细则第 22 条的规定。
- ☐权利要求 不符合专利法实施细则第 23 条的规定。

上述结论性意见的具体分析见本通知书的正文部分。

6. 基于上述结论性意见, 审查员认为:

- ☒申请人应按照通知书正文部分提出的要求, 对申请文件进行修改。
- ☐申请人应在意见陈述书中论述其专利申请可以被授予专利权的理由, 并对通知书正文部分中指出的不符合规定之处进行修改, 否则将不能授予专利权。
- ☐专利申请中没有可以被授予专利权的实质性内容, 如果申请人没有陈述理由或者陈述理由不充分, 其申请将被驳回。

7. 申请人应注意下述事项:

- (1) 根据专利法第 37 条的规定, 申请人应在收到本通知书之日起的肆个月内陈述意见, 如果申请人无正当理由逾期不答复, 其申请将被视为撤回。
- (2) 申请人对其申请的修改应符合专利法第 33 条的规定, 修改文本应一式两份, 其格式应符合审查指南的有关规定。
- (3) 申请人的意见陈述书和 / 或修改文本应邮寄或递交国家知识产权局专利局受理处, 凡未邮寄或递交给受理处的文件不具备法律效力。
- (4) 未经预约, 申请人和 / 或代理人不得前来国家知识产权局专利局与审查员举行会晤。

8. 本通知书正文部分共有 2 页, 并附有下列附件:

- ☐引用的对比文件的复印件共 份 页。

审查员: 张莉(B527)

2006 年 8 月 22 日

审查部门

材料审查部



第一次审查意见通知书正文

申请号：038021676

该申请涉及一种水性基材处理组合物、利用所述组合物对基材进行处理的方法以及通过所述方法处理的金属材料。经审查，具体意见如下：

1. 权利要求1和3不清楚，不符合专利法实施细则第20条第1款的规定。权利要求1中“选自脱乙酰壳多糖和脱乙酰壳多糖衍生物中的至少一种脱乙酰壳多糖（A）”中前面的“脱乙酰壳多糖”和后面的“脱乙酰壳多糖（A）”的名称相同，都是“脱乙酰壳多糖”，而实际上二者所表示的物质又不相同，从而造成权利要求1不清楚；权利要求3中“脱乙酰壳多糖衍生物是脱乙酰壳多糖”的逻辑不清楚。

2. 权利要求1和5得不到说明书的支持，不符合专利法第26条第4款的规定。权利要求1中的“脱乙酰壳多糖衍生物”概括了一个较大的范围，而根据说明书的描述，合成所述的“脱乙酰壳多糖衍生物”时，即将取代基引入到脱乙酰壳多糖上时，取代基的引入程度基于脱乙酰壳多糖内的单体单元应在6.0的范围内，当引入程度大于6.0时将会导致防水性的劣化。由此可见，并非所有的“脱乙酰壳多糖衍生物”都能达到同样的技术效果，所述概括得不到说明书的支持；权利要求5中的“M”在说明书中不存在，因此导致权利要求5得不到说明书的支持。

3. 权利要求1缺少必要技术特征，不符合专利法实施细则第21条第2款规定。权利要求1要求保护一种水性基材处理组合物，根据说明书的描述，其要解决的技术问题是：现有技术中的处理组合物所得到的金属材料的涂布层的耐用粘合性、耐溶剂性和耐腐蚀性方面存在不足。解决上述问题所采用的技术方案是：采用一定浓度和比例脱乙酰壳多糖和特定的金属化合物的水性基材处理组合物对基材进行处理。而权利要求1中缺少二者的浓度以及脱乙酰壳多糖（A）与金属化合物的比例，对于组合物来说，各成分的浓度以及比例是必不可少的，因为不同浓度和比例的组合物其效果差别极大。因此，申请人应当补入解决所述技术问题所必须的与各成分的浓度和比例相关的技术特征。

4. 权利要求8不清楚，不符合专利法实施细则第20条第1款的规定。其中的“诸如”在一项权利要求中概括出了不同的保护范围，从而导致权利要求的保护范围不清楚。

基于上述理由，本申请按照目前的文本不能被授予专利权。如果申请人按照本通知书提出的审查意见对申请文件进行修改，克服所存在的缺陷，则本申请可望被授予专利权，否则本申请将被驳回。请申请人注意，对申请文件的修改应当符合专利法第33条的规定，不得超出原说明书和权利要求书记载的范围。

申请人在提交修改文本时应当提交：第一，修改涉及的那一部分原文的复印件，并在该复印件上用红笔标注出所作的增加、删除或替换；第二，重新打印的替换页，用于替换相应的原文。申请人应当确保上述两部分在内容上的一致性。

审查员：张莉

代码：B527